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EXAMINER

BRUCKART, BENJAMIN R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/828,543	Applicant(s) COSTA-REQUENA ET AL.	
	Examiner BENJAMIN R. BRUCKART	Art Unit 2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,12-14,17,19,22,33,34 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,12-14,17,19,22,33,34 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims:

Claims 1, 2, 5-10, 12-14, 17, 19, 22, 33, 34, 36-39 are pending. Claims 1, 14, 22 and 33 are independent.

Claims 3, 4, 15, 16, 18, 20, 21, 23-32, 35, 40 and 41 remain cancelled.

Claims 14, 19, 22 and 33 are amended.

The examiner brings to applicant's attention the new examiner of record. Please note new and updated correspondence information presented below.

Response to Arguments

Applicant's arguments filed in the amendment filed 7/27/09, have been fully considered but they are not persuasive. The reasons are set forth below.

Applicant's invention as claimed:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 2, 5-10, 12-14, 17, 19, 22, 33, 34, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara (US 2002/0132608) (cited by applicant in IDS) in view of Zehier et al. (US 2004/0136027) in view of Coussement (US 2002/0114278).

Referring to claim 1, Shinohara discloses a method of exchanging multimedia data between a multimedia device (i.e. terminal 20) and a network (i.e. network 60), comprising:

digitally coupling a communication device (i.e. telephone 10) to the multimedia device (Figure 1; ¶ 35);

storing, on a data store (i.e. MMS user database server 30) accessible via the network (i.e. network 60), a profile (i.e. data) of the communications device (i.e. mobile telephone 10₁₋₄), the profile adapted to include a description of multimedia capabilities of the multimedia device (i.e. extension of the range of formats that each of the mobile telephones can receive...the current connection of external terminal 20₁ to mobile telephone 10₁ enables the reception of not only multimedia data of format 1, but of multimedia data, media data of format 2, that includes video data of format V2. The arrows in FIG. 4 indicate that the media type is the same as the media type of format 1) (Figure 4; ¶ 39-40);

accessing the profile for purposes of formatting the multimedia data via a network entity (i.e. results of the determination as to what the receiver formats can be received) (e.g. abstract);

formatting the multimedia data (i.e. multimedia message) via the network entity (i.e. transmitting entity) based on the profile so that the data is compatible with the multimedia device (i.e. based on the determination, alter the message to conform to the format the receiver can receive) (e.g. abstract); and

exchanging the multimedia data between the multimedia device and the network via the communications device (i.e. transmission and reception of data) (e.g. abstract; ¶ 54).

Shinohara does not specifically disclose obtaining a UPnP device descriptor of a multimedia device via a UPnP network forming a user agent profile, and discovering the multimedia capabilities of the device via the UPnP network, rather that the telephone is “coupled” to the external terminal 20 and that a profile is created.

In analogous art, Zehier discloses another multimedia service providing system which discloses, in a UPnP network, receiving, at a host 12, an advertisement (read: UPnP device descriptor), including multimedia capabilities, for a service 24 from a device 14, augmenting the

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host's device capabilities description file 30, and publishing the new service to a particular server to be used by particular clients (Figures 1-2, refs. 42-46; ¶ 24, 29, 35) in order to allow a distributed capability and preference discovery that is easily implemented, readily upgradeable, and unlimited by central control (Page 3, para 25).

It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow a distributed capability and preference discovery that is easily implemented, readily upgradeable, and unlimited by central control (Page 3, para 25).

Shinohara-Zehier does not explicitly disclose the particular format of the device profile, but does disclose that it conforms to the UPnP specifications (Zehier: ¶ 24).

In analogous art, Coussement discloses another terminal capability determination system which discloses the profile comprises a user/agent profile (¶ 21) in order to organize and propagate the preferences throughout the network (Coussement: page 3, para 21).

It would have been obvious to one of ordinary skill in the art to substitute the profile format used in Shinohara with the profile format described in Coussement in order to organize and propagate the preferences throughout the network (Coussement: page 3, para 21).

Referring to claim 2, Shinohara discloses the multimedia device comprises an audio playback device (i.e. format 2 is capable of playing the media type of "audio") or a television (the Office construes any device which is capable of playing motion video a television, such as the terminal which is capable of playing a different version of video file) (Figure 4; ¶ 38-42).

Referring to claim 5, Shinohara-Zehier-Coussement discloses the use of a Profile-Diff header in a message sent to the data store in order to update the profile information (i.e. since Coussement discloses the use of CC/PP repository, it inherently discloses the use of a Profile-Diff header since this is defined as part of the CC/PP exchange protocol, see Ohto et al. "CC/PP exchange protocol based on HTTP Extension Framework" W3C Note 24 June 1999) (¶ 21).

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Referring to claim 6, Shinohara-Zehier discloses the invention as described in claim 1.

Shinohara-Zehier does not explicitly disclose the particular format of the device repository. In analogous art, Coussement discloses another terminal capability determination system which discloses the use of a CC/PP repository (§ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile repository of Shinohara with the profile repository used in Coussement in order to provide the benefits commonly known to the use of CC/PP repository, such as providing a standardized mechanism and profile format for servers to be aware of device capability information.

Referring to claim 7, Shinohara discloses the network entity comprises a MMSC (i.e. multimedia message service) (Figure 1; ¶ 10).

Referring to claim 8, Shinohara discloses the invention substantively as described in claim 1. Shinohara does not explicitly disclose that when the terminal is uncoupled from the mobile telephone, the profile is updated to remove the description of the multimedia capabilities of the multimedia device. In analogous art, Zehier discloses another device service providing system which discloses that the profile is updated when a service is unavailable to indicate that the service is no longer available (i.e. removing a service) (§ 34). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

Referring to claims 9 and 10, Shinohara discloses the communication device comprises a wireless mobile terminal (i.e. a mobile telephone 10) (Figure 1).

Referring to claim 12, Shinohara discloses the invention as described above. Shinohara does not explicitly disclose the communication device is configured to act as an internet gateway for the UPnP network. In analogous art, Zehier discloses another internet multimedia device wherein the root device acts as a gateway for the UPnP network (i.e. device 14 does not connect to the

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network, rather goes through the host acting as a proxy) (Figure 1). It would have been obvious to one of ordinary skill in the art to couple the terminal of Shinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

Referring to claim 13, Shinohara-Zehier discloses the invention as described in the claims above. Shinohara-Zehier does not explicitly disclose that the UPnP network is wireless, however a wireless UPnP network is well known in the art. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for a wireless UPnP network is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Shinohara-Zehier to connect the device 14 to the host 12 via a wireless connection in order to promote roaming and the ability for the mobile user of Shinohara to freely move about without connecting to a network via a wired connection.

Claims 14, 17, 19, 22, 33, 34, 36-39 are rejected for similar reasons as stated above.

REMARKS

Applicant has presented minor amendments to the claims and presented arguments.

The Applicant Argues:

On pages 7 and 8 of the remarks, applicant argues the office is not giving proper weight to the claim limitations.

In response, the examiner respectfully submits:

The office has given proper patentable weight to each and every limitation in the claims. The specific limitation in question is the "forming, based on a universal plug and play descriptor, a user agent profile on a data store accessible via a mobile communications network, said user agent profile describing multimedia capabilities of the multimedia device for purposes of rendering multimedia messaging service data."

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With respect that the above limitation, Shinohara teaches forming a user agent profile on a data store accessible via a mobile communications network, said user profile describing multimedia capabilities of the multimedia device for purposes of rendering mms data on page 3, para 35, 39-40. Shinohara Figure 1 and Figure 3 show the network architecture of mobile devices connected to a network (tag 60). Tag 30, the MMS user database server, stores "information regarding the media type of data that can be received as a message by each of mobile telephones and the format for each media type that can be received (processing capability information for each media type for each of mobile telephone" (para 36). The profile for each device is that devices capabilities and media type that can be received on that phone.

The Shinohara reference does not teach UPnP descriptors or that the profile is formed on them but does teach the formatting and communicating messages in the devices compatible formats.

Zehier reference teaches the function of forming a profile based on device capabilities in a UPnP environment where device capabilities are discovered using advertisements and registration (Zehier: pages 3-4, para 24, 29, 30).

The modified Shinohara reference fails to explicitly teach disclose the particular format of the device profile.

However, in analogous art, the Coussement references teaches the composite-capability/preference profiling CC/PP standard in which devices announce and dictate their preferences and capabilities in order to organize and propagate the preferences throughout the network (Coussement: page 3, para 21).

On page 8 of the remarks, applicant argues the combination of references do not teach forming any profile describing multimedia capabilities for purposes of the rendering mms data based on a universal plug and play descriptor.

In response, the examiner respectfully submits:

The Universal Plug and Play descriptor is described in the specification (instant specification publication para 63) as an XML template based standard that describes capabilities of the multimedia device (para 64). The Shinohara reference teaches storing and access to

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profiles of device capabilities. While Shinohara does not explicitly teach a plug and play environment for open sharing of device capabilities, the Zehier provides this evidence. Further, the Coussement reference reinforces the idea that a standard for preferences and capabilities of devices was known and utilized at the time of the invention to allow organized and easy propagation the preferences throughout the network (Coussement: page 3, para 21). The combination of these features rendered the claim unpatentable.

On page 9 of the remarks, it seems applicant is mischaracterizing the reference Coussement by pointing to teaching that are not relied upon in the action. The only substituted/borrowed/replicated feature common in the art was the feature of the CC/PP announcement and profile data for device capabilities and preferences (para 21). While Coussement teaches other features such as presence agents and proxies, those are not the features relied upon and imported into modified Shinohara for showing an obvious variation of the invention.

On page 10 of the response, applicant cites the KSR decision arguing the combination is not permissible and relies on hindsight reasoning.

First, regarding hindsight reasoning, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Secondly, KSR provides rationales that support the combination. The examiner has already produced motivation by meeting the TSM test showing the reasons for combining the features from the different references.

Further rations such as

A) Combining prior art elements according to known methods to yield predictable results (in this case using the UPnP environment of Zehier and the CC/PP announcing and registration with Shinohara) to provide format and delivery of device specific content.

B) Simple substitution of one known element for another to obtain predictable results

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(UPnP and CC/PP are known elements combined with Shinohara to allow devices to announce their capabilities and receive appropriate content).

C) Use of known techniques to improve similar devices in the same way (see A and B).

D) Applying a known technique to a known device ready for improvement to yield predictable results (See A and B again).

Lastly, the cited prior art references are all analogous in nature and relevant to the instant invention claim language. Applicant has not provided any arguments or evidence of teaching away or motivation to not combine the references, only arguing the inventions singly.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R. Bruckart whose telephone number is (571) 272-3982. The examiner can normally be reached on 9:00-5:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on (571) 272-

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6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin R Bruckart
Examiner
Art Unit 2446

/Benjamin R Bruckart/
Primary Examiner, Art Unit 2446